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April 18, 2005

**VIA FACSIMILE**

To: Examiner Len Tran  
Group Art Unit No. 1725  
U.S.P.T.O.

Facsimile No.: (703) 872-9306

From: Scott M. Tulino, Esq.

Facsimile No.: (703) 761-2375

Re: Enclosed Petition Under 37 C.F.R. §1.181 to Withdraw Finality of  
Rejection as Premature  
U.S. Patent Application Serial No.10/689,401  
Our Reference: FUJ.060

Dear Examiner Tran:

Enclosed is a Petition Under 37 C.F.R. §1.181 to Withdraw Finality of Rejection as Premature, which we request that you enter and subsequently issue a new Non-final Office Action.

Thank you in advance for your kind consideration on this case.

Very truly yours,

Scott M. Tulino, Esq.  
Sean M. McGinn, Esq.

SMT:SMM:lg  
Enclosure

Total No. of Pages Transmitted: 3

## UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Hiroyuki Noguchi, et al.

Serial No.: 10/689,401

Group Art Unit: 1725

Filed: October 21, 2003

Examiner: Len Tran

For: METHOD OF CASTING ALUMINUM OR ALUMINUM ALLOY

Honorable Commissioner of Patents  
Alexandria, Virginia 22313-1450  
Box AF

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**PETITION UNDER 37 C.F.R. §1.181 TO WITHDRAW FINALITY OF REJECTION  
AS PREMATURE**

Sir:

Applicant respectfully petitions under 37 C.F.R. §1.181 that the finality of the Examiner's rejection be withdrawn as premature under the guidelines of MPEP §706.07(a). This guideline states: "...second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims..." (Emphasis by Applicant).

Applicant respectfully submits that the Examiner's new ground of rejection was not necessitated by Applicant's amendment of the claims. Specifically, in Applicant's previous Amendment (filed on January 27, 2005) independent claim 1 was merely editorially amended. That is, no substantive limitations were added to independent claim 1.

In the present Office Action, the Examiner's new ground of rejection rejects claims 1, 9-11 and 13 as being unpatentable over Sutton in view of George. However, nowhere was claim 1 substantively amended to necessitate this new ground of rejection (set forth above).

Indeed, claim 1 was amended in the January 27, 2005 Amendment as follows:

A method of casting aluminum alloy comprising the steps of:  
producing a sand mold;  
injecting at least one of molten aluminum or and molten aluminum alloy into the sand mold;

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FUJ.060

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cooling a casting thus obtained together with the sand mold by means of at least one  
of water or and a liquid coolant; and  
dismantling the sand mold.

Therefore, Applicant submits that it does not appear that the Examiner's new search and subsequent new grounds of rejection were based on Applicants' amendment of the claims.

Even a cursory review of the claims will indicate that the claims merely contained editorial amendments, and were not amended to overcome Kashima and Sutton in the previous Office Action.

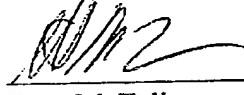
Applicant submits that no claim amendments were necessary for claim 1 to overcome the previous grounds of rejection and that the amendments were clearly not so intended, as clearly stated in the remarks of the previous Amendment (see Amendment filed January 27, 2005 at page 5).

Therefore, because independent claim 1 was not substantively amended, the finality of the Examiner's rejection is premature.

For at least the reasons outlined above, Applicants petition that the finality of rejection for the above-identified Application be withdrawn.

Respectfully Submitted,

Date: April 18, 2005

  
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Docket No. 03FI001US  
FUJ.060

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**FACSIMILE TRANSMISSION**

I hereby certify that I am filing this paper via facsimile, to Group Art Unit 1725, at (703) 872-9306, on April 18, 2005.

Respectfully Submitted,

Date: April 18, 2005

  
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